

REMARKS

Claims 1-35 stand rejected, with claim 36 withdrawn from consideration.

Claims 1, 8, 17 and 35 have been amended and claims 2, 9, 18 and 36 cancelled without prejudice. Therefore, claims 1, 3-8, 10-17 and 19-35 are the only claims remaining in this application.

Applicants note that the present application is a national phase entry of a PCT application designating the United States. Applicants have claimed priority and the Notification of Acceptance mailed May 24, 2001 indicates that the priority document has been received by the U.S. Patent and Trademark Office. Accordingly, acknowledgment on the Office Action Summary Sheet, preferably an indication at blocks 13, 13a, and 13a3, confirming applicants' claim for priority and receipt of the certified copy of the priority document is respectfully requested.

It is also noted that applicants submitted with the filing of this national phase entry a PTO Form 1449 listing prior art of record in the PCT application. Applicants also note that the Notice of Acceptance also indicates that the U.S. Patent Office received a copy of the International Search Report and copies of the references cited therein. It is requested that the Examiner specifically acknowledge receipt of the Information Disclosure Statement and consideration of the references by initialing and dating each one and returning a copy to the undersigned.

The Examiner previously made a telephone restriction requirement and applicants orally elected to prosecute the invention of Group I with traverse. Applicants affirm the election of Group I claims 1-35 with traverse.

Claim 35 stands rejected under 35 USC §112 (second paragraph) as being indefinite. Applicants have amended the dependency of claim 35 to depend from claim 34, rather than claim 25. Claim 34 has sufficient antecedent basis for the term "porosification" and therefore no further amendment is needed.

Claims 1-16 stand rejected under 35 USC §102 as being anticipated by Ginavan (U.S. Patent 5,457,041). Applicants have amended independent claims 1, 8 and 17 to specify that the claimed invention is a method of providing a silicon micro-needle where the needle has a duct passing from the needle base to the needle tip.

The Examiner alleges that the Ginaven reference teaches in Figure 1 the region between tip 28 and base adjoining substrate 16 and that that region reads on applicants' "duct." In Figure 1 of Ginaven, the Examiner is presumably referring to the three dotted line segments, one of which indicates the diameter of the needle and the other of which indicates the needle spacing. Clearly neither of these indicate a duct in a needle between the base and the tip, as recited in applicants' method claim.

Because Ginaven fails to teach the method steps of providing a silicon micro-needle having a base, a tip and a duct passing from the base to the tip, it cannot anticipate

applicants' claim. Accordingly, any further rejection of claims 1-16 as being anticipated by Ginavan is respectfully traversed.

Claims 17-35 stand rejected as being unpatentable over Ginavan in view of Busta (U.S. Patent 5,137,817). Inasmuch as the same limitation as discussed above with reference to the Ginavan reference is included in applicants' independent claim 17, and remaining claims 19-35 all ultimately depend from claim 17, the above comments regarding the Ginavan reference are herein incorporated by reference.

The Examiner's admission that "Ginavan does not disclose a two-material micro needle as the claimed invention does" is very much appreciated. Moreover, it is noted that while Busta teaches electrodes, there is no reason or motivation for one of ordinary skill in the art to combine the teaching of Busta with the alleged micro-needle teaching in Ginavan. Furthermore, the disclosure of a product in Busta does not necessarily disclose a method of providing a product. How or why the Examiner believes Busta discloses applicants' claimed method of forming a silicon micro-needle having a duct passing from the base to the tip is not seen and clarification is respectfully requested.

Should the Examiner continue the rejection of claims 17 and 19-35, it is requested that the Examiner specifically indicate where in either reference there is the teaching of a method or method step for providing the duct as recited in applicants' claims. Should the Examiner find some teaching, then the Examiner is respectfully requested to identify how or where one of the references contains any teaching or suggestion for combining the

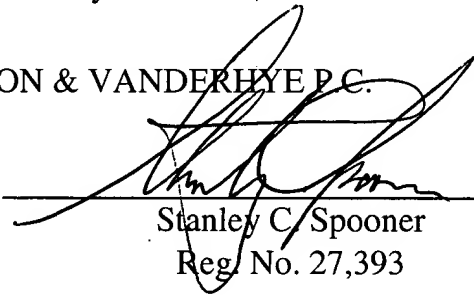
teachings in the manner of applicants' claims and thereby rendering obvious applicants' claimed method. Applicants submit that there is no reason for combining these references and even if the references were combined, there would be no teaching of applicants' claimed method steps, and therefore any further rejection thereunder is respectfully traversed.

Having responded to all objections and rejections set forth in the outstanding Official Action, it is submitted that remaining claims 1, 3-8, 10-17 and 19-35 are in condition for allowance and notice to that effect is respectfully solicited. In the event the Examiner is of the opinion that a brief telephone or personal interview will facilitate allowance of one or more of the above claims, the Examiner is respectfully requested to contact applicant's undersigned representative.

Respectfully submitted,

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